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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,147	11/21/2000	Subhash C. Roy	1 TRA-ONEX-002	1902

7590 05/07/2003  
David P. Gordon, Esq.  
65 Woods End Road  
Stamford, CT 06905

EXAMINER

NGUYEN, BRIAN D

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/717,147

Applicant(s)

ROY ET AL.

Examiner

Brian D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on the amendment filed 2/19/03 and 3/6/03.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-21, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 10 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 2, 12-14, and 24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8, and 9 of copending Application No. 09/717,999. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the claimed invention are described in claims 1, 6, 8, and 9 of copending Application No. 09/717,999 with different wording and/or arrangement. Therefore, it is obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 12-14, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorshe (5,412,651) in view of Wynn et al (6,275,499).

Regarding claims 1 and 13, Gorshe discloses a method comprising generating a repeat data frame having a plurality of rows (see col. 1, lines 44-46); making requests for space (see col. 3, lines 29-37; col. 6, lines 62-68; and Figure 5); and granting the requests through an out-of-band link (see lines 531-533 of Figure 5). Gorshe does not specifically disclose arbitrating the request and the request is made during row N for space in row N+1. However, arbitrating the request is well known in the art. Wynn discloses arbitrating the request is well known (see col. 18, lines 4-25). Gorshe in view of Wynn does not specifically disclose the request is made during row N for space in row N+1; However, it is obvious that the request must be made during row N for space N+1 because based on the SONET standard, it is impossible to make a request and transmitting data in the same row of a frame.

Regarding claims 2 and 14, Gorshe further discloses each request includes through-the switch routing information and priority level information (see col. 3, lines 61-63).

Regarding claim 12 and 24, Gorshe further discloses the requests are made out-of-band (see lines 531-533 of Figure 5).

5. Claims 3-4 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorshe (5,412,651) in view of Wynn et al (6,275,499) as applied to claims 1-2 and 13-14 above, and further in view of Chiussi et al (5,689,506).

Regarding claims 3-4 and 15-16, Gorshe in view of Wynn disclose all the claimed subject matter as described in previous paragraph except for the switch is a multistage switch and buffering the request at each stage of the switch. However, multistage switch and buffering the request at each stage of the switch is well known in the art. Chiussi discloses a system using multistage switch and buffering the request at each stage of the switch (see abstract; Figure 11; and col. 3, lines 13-26). Therefore, it would have been obvious to a person of ordinary skill in the art to use the multistage switch and buffering the request at each stage of the switch as taught by Chiussi in the system of Gorshe in view of Wynn so that more switching can be performed by the switch.

6. Claims 5-9 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorshe (5,412,651 in view of Wynn et al (6,275,499) as applied to claim 1 above, and further in view of Bergantino et al (6,359,891).

Regarding claims 5-9 and 17-21, Gorshe in view of Wynn disclose all the claimed subject matter as described in previous paragraph except for the packet is 52-bytes. However, Bergantino discloses a packet includes 52-bytes rather than 53 bytes (see col. 15, lines 27-28). Therefore, it would have been obvious to a person of ordinary skill in the art to segment each packet larger than 52-bytes into 52 byte chunks as taught by Bergantino in the system of Gorshe in view of Wynn in order to meet specific needs.

7. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorshe (5,412,651 in view of Wynn et al (6,275,499) as applied to claim 1 above, and further in view of Chow et al (6,148,349).

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Regarding claims 11 and 23, Gorshe in view of Wynn disclose all the claimed subject matter as described in previous paragraph except for the requests are made in-band. However, Chow discloses the use of in-band and out-of-band links for transmission of messages (see col. 26, lines 26-27). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use in-band for the requests as taught by Chow in the system of Gorshe in view of Wynn since the use of in-band or out-of-band is a matter of design choice.

#### ***Allowable Subject Matter***

8. Claims 10 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian D Nguyen whose telephone number is (703) 305-5133. The examiner can normally be reached on 7:30-6:00 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Olms can be reached on (703) 305-4703. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

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BN

May 4, 2003

A handwritten signature in black ink, appearing to read 'Brian Nguyen', with a stylized, cursive script.

Brian Nguyen